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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/178,329	10/23/1998	MICHAEL R. NOWAK	E4919-00003	4360
8933	7590	07/25/2011		
DUANE MORRIS LLP - Philadelphia			EXAMINER	
IP DEPARTMENT			JACKSON, MONIQUE R	
30 SOUTH 17TH STREET			ART UNIT	
PHILADELPHIA, PA 19103-4196			PAPER NUMBER	
			1787	
			MAIL DATE	
			DELIVERY MODE	
			07/25/2011	
			PAPER	

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. NOWAK, LOUANN S. MUELLER and
WILLIAM R. ARNDT

Appeal 2011-000126
Application 09/178,329
Technology Center 1700

Before PETER R. KRATZ, CATHERINE Q. TIMM, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's continued refusal to allow claims 25, 26, 28-35, and 37-58. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' invention is directed to a wrapped ream of paper wherein a laminated composite wrap material wraps the ream of paper, the wrap comprising an adhesive layer located between a paper layer and a polymer film layer, the paper or polymer film layer being printed before lamination.

Claim 25 is illustrative and reproduced below:

25. A wrapped ream of paper, comprising:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said second layer of polymer film material is printed before lamination.

In addition to prior art admissions¹¹, the Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Peer, Jr. 4,254,173 Mar. 3, 1981

Claims 25, 26, 28-35, and 37-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art taken in view of Peer.

We adopt the Examiner's factual findings as our own and we affirm the stated rejection for substantially the reasons set forth by the Examiner in the Answer. We add the following for emphasis.

¹¹ Spec. pp. 1-2 (*see* Ans. 3). Appellants do not dispute the Examiner's reliance on the background information provided in the Specification regarding conventional wrappers for reams of paper as admitted prior art (*see generally* App. Br. and Reply Br.).

All of the rejected claims are argued together as a group. We select claim 25 as the representative claim on which we decide this appeal.

There is no dispute that the Examiner's proposed modification of the admitted prior art wrappers for forming a wrapped ream of paper based on the additional teachings of Peer would have resulted in a wrapped product corresponding to the claimed product (App. Br. 4-6; Reply Br. 2²-4). Rather, Appellants urge that there is no teaching or suggestion in Peer to steer one of ordinary skill in the art toward the employment of the teachings of Peer regarding a pre-printed laminated composite packaging material comprising an adhesive layer between a printed polymer film layer and a paper layer as being useful material for the prior art wrap for a ream of paper (App. Br. 5-6; Reply Br. 3-4).

PRINCIPAL ISSUE

Have Appellants indicated reversible error in the Examiner's obviousness rejection by asserting a lack of suggestion or legally sufficient motivation for the Examiner's proposed combination of the admitted prior art with Peer?

SUMMARY DISPOSITION

We answer the aforementioned question in the negative, and we affirm the stated rejections for substantially the reasons set forth in the Examiner's Answer.

² We reference the second page of the Reply Brief as page number "2" (Appellants incorrectly assign the number "4" to the second page of the Reply Brief).

PRINCIPLES OF LAW

On appeal to this Board, Appellants must show that the Examiner erred in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) (2000).

“‘Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.’” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)).

ANALYSIS

Appellants argue that Peer does not provide direction for the Examiner’s proposed combination because Peer is directed to secondary container packaging, not primary product wrap and that modifying the packaging of Peer to be a primary product wrap would result in a product that is not suitable for its desired secondary packaging purposes (App. Br. 6; Reply Br. 3-4). Thus, Appellants conclude that the Examiner is employing

Appellants' Specification for an impermissible hindsight reconstruction of the claimed invention.

This argument is not persuasive because the Examiner has furnished an apparent reason for one of ordinary skill in the art to combine the teachings of Peer with the admitted prior art; that is, to furnish a higher strength and tear-resistant wrapping for the ream of paper with abrasion resistant printing being applied (Ans. 3-6; see Peer, col. 1, l. 54- col. 2, l. 2; col. 6, ll. 57-68, col. 7, ll. 35-40, col. 8, ll. 49-52).

We recognize, of course, that Peer discloses that the composite material described therein is useful as secondary container packaging, as argued (Peer, col. 1, ll.10-51). However as pointed out by the Examiner and as would be recognized by one of ordinary skill in the art, Peer generally teaches that what is taught therein "relates to container packaging ..." (Ans. 5; col. 1, ll. 7-9).

Moreover, the Examiner relies on the admitted prior art for the use of a composite packaging material comprising paper and polyethylene as a primary container package for a ream of paper (Ans. 3-6; Spec. 1-2). It is well settled that a rejection premised upon a proper combination of references cannot be overcome by attacking the references individually. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

Furthermore, and as would have been well understood by an ordinarily skilled artisan at the time of the invention, Appellants acknowledge that retail store wrap for a ream of paper should be resistant to breakage (Spec. 1). Hence, given the combination of the teachings of the applied prior art, there is ample direction that would have led an ordinarily skilled artisan to select a polymer film/ paper composite material that resists

tearing and breakage as taught by Peer to form a packaging wrap for a ream of paper. As the Supreme Court explained in *KSR*, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S.at 418. After all, one of ordinary skill in the art is presumed to have skills apart from what the prior art references expressly disclose. *See In re Sovish*, 769 F.2d 738, 742 (Fed. Cir. 1985). In this regard, Appellants do not argue that the composite material of Peer would not have been useful for forming a primary package wrap for a ream of paper.

Peer is not applied alone, and the need for tear-resistant package material extends to primary container packages, such as those employed for a ream of paper, as one of ordinary skill in the art would have readily recognized based on the combined teachings of the applied prior art. It follows that the Examiner’s rationale for the proposed combination is reasonable and is not refuted by Appellants limited and narrow reading of the teachings of Peer with respect to secondary container packages.

Consequently, it is our view that the teachings of Peer respecting a tear-resistant and printable composite material are consonant with the known requirements for a packaging wrap for a ream of paper. Hence, it is our judgment that one of ordinary skill in the art would have been led to the claimed subject matter via a combination of the prior art teachings as proposed by the Examiner upon the exercise of routine skill.

CONCLUSION/ORDER

The Examiner’s decision to reject the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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